

## **II. REMARKS**

### **Status of the Claims**

Claims 1-8 remain under consideration.

### **Summary of the Office Action**

Claims 1-8, stand rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, G.B. Patent No. 2,294,844 in view of the disclosure of Laurila, et al, U.S. Patent No. 6,591,116. Claims 3 and 4 stand rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, in view of the disclosure of Laurila, et al, in further view of the reference Henry, Jr. et al, U.S. Patent No. 5,603,084. Claims 5 and 6 stand rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, in view of the disclosure of Laurila, et al, in further view of the reference Henry, Jr. et al, and further in view of Retzer, et al, U.S. Patent No. 6,009,325. Claim 7 stands rejected under 35USC103(a) on the basis of the cited reference Van den Heuvel, in view of the disclosure of Laurila, et al, in further view of the reference Retzer, et al. The Examiner is respectfully requested to reconsider his rejection in view of the following remarks.

### **The Invention**

In the system of this invention, language consistent with Universal Mobile Telecommunications are employed to collect and compile network characteristic data within the memory of the mobile station. These data are combined with the universal subscriber data and service data resident in the mobile station to generate a matrix of available configuration parameters. From

this data a configuration is selected for operation of the mobile station within the network.

#### **Discussion of the Cited References**

The examiner has cited the reference van den Heuvel, et al as its primary support for the rejection of claims 1 and 8 on the basis of obviousness. This reference teaches a system for providing a selection process for a subscriber to allow the use by a subscriber of certain features available in multiple communications systems. It requires an initial contact with a common system to receive information on available networks and their features. The subscriber may select a desired network and feature, download the required software, and then contact the selected network. There is no capability for doing this from data stored on the mobile phone, but it is totally reliant on the service of the common system.

The rejection under 35USC103(a) combines the teaching of Van den Heuvel in combination with the reference Laurila. Laurila is cited for its teaching of an integrated circuit card which stores information about the operational capabilities of the card in each of a plurality of networks. This reference, however, is not a proper reference under 35USC103(c) because it is owned by Nokia Corporation, the owner of the subject application, and is prior art based on 35USC 102(e). Section 103(c) specifically indicates that such a reference will not preclude patentability where the subject matter of the reference was commonly owned at the time of the invention.

"(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the



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invention was made, owned by the same person or subject to an obligation of assignment to the same person."  
[35USC103(C) (c) ]

This effectively removes the reference Laurila from consideration. Since the Examiner relies on this reference in support of each of the claim rejections, the rejection of the claims under 35USC103(a) must accordingly fail.

The additional cited references Henry, et al, and Retzer, et al do not remedy the deficiencies of the teaching of Van den Heuvel. In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of \$110 is enclosed for a one month extension of time. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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2 APRIL 2004

Date

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